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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,400	04/13/2004	Ralph Bauer	1055-A4363	3239
34456 7590 02/17/2009 LARSON NEWMAN ABEL & POLANSKY, LLP 5914 WEST COURTYARD DRIVE SUITE 200 AUSTIN, TX 78730				
EXAMINER YOON, TAE H				
ART UNIT		PAPER NUMBER		
1796				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,400

Applicant(s)

BAUER ET AL.

Examiner

Tae H. Yoon

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 7, 10-22, 24, 26-34 and 55-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7, 10-22, 24, 26-34 and 55-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4, 7, 10-22, 24, 26-34 and 55-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is New Matter rejection since the recited "flow and leveling of at least 6 (and other recited numbers)" has no support in originally filed specification wherein "at least 6 mils" is taught for example. See PP [0037] and table 1 of the published document US 2005/0227000 A1. ASTM D2801 for measuring said flow and leveling is noted in PP [0035], and applicant must submit a copy of said ASTM D2801 showing said flow and leveling without a unit such as mils published before the instant filing date in order to overcome the rejection. Any amendment to the specification would be needed also.

Claims 1, 4, 7, 10-22, 24, 26-34 and 55-59 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the coating composition comprising the recited components and amounts thereof in examples, does not reasonably provide enablement for the recited component. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Applicant's new 1.132 declaration shows that the recited values for flow and leveling and sag resistance are not common for any given coating composition. Thus, undue experimentation would be needed in order to find out said values for different compositions (components and amounts thereof). Note that the mandatory components recited in claims are only a polymer in an emulsion (or latex) without any amount and 0.1 to 20.0 wt% of the recited boehmite particles. The compositions used in said 1.132 declaration actually would fall in scope of the instant composition claims, but do not have the recited values for flow and leveling and sag resistance even though they contain a large amount of additives such as pigment. This is based on the fact that Dispersal Sol P2 of Elsik inherently possesses the instantly recited properties since applicant failed to show that Dispersal Sol P2 does not have such properties (applicant has Dispersal Sol P2 and thus applicant must have an information data sheet or applicant could measure such properties, but failed to do so).

Furthermore, a composition comprising 1 wt% of a latex and 0.1 wt% of the recited boehmite particles falls within scope of the instant claims, but such composition would not have recited values for flow and leveling and sag resistance based on new 1.132 declaration in which a large amount of solid component (rutile titanium dioxide and a latex) which improves said flow and leveling and sag resistance properties are used, and applicant failed to show otherwise.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 7, 10-22, 24, 26-34 and 55-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "flow and leveling of at least 6 (and other recited numbers)" lacks antecedent basis in originally filed specification wherein "at least 6 **mils**" is taught for example, and thus it is indefinite.

The recited values for flow and leveling and sag resistance are indefinite absent the time of measurement since applicant's 1.132 declaration shows that such values would change with time (see an example with Catapal D in Table D2).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 7, 10-12, 15, 17-22, 24, 26, 27, 29, 31-34 and 55-59 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Elsik et al (US 5,550,180).

Rejection is maintained for reason of record with following response.

Applicant's new 1.132 declaration has been considered, but found insufficient to overcome the rejection.

1. Dispersal Sol P2 used in examples 1 and 3 of Elsik et al inherently possesses the instantly recited properties since applicant failed to show that Dispersal Sol P2 does not have such properties (applicant has Dispersal Sol P2 and thus applicant must have an information data sheet or applicant could measure such properties, but failed to do so other than stating that the PTO appears to have confused crystallite size with particle size).

2. The examiner had pointed out that particular latex paints (which would fall within the claimed composition absent further limitation to the instant composition) are taught by Elsik et al, and thus any comparison must be based on the paint of Elsik et al, not on applicant's own choice as in the previously filed applicant's 1.132 declaration and Exhibits in last office action. Applicant's new 1.132 declaration failed to address the examiner's concern.

3. Note that clay is one well known thickeners also taught by applicant, PP [0020] of US 2005/0227000 A1. For example, example 3 of Elsik et al contains a large amount of clay (12.71 wt% of Minex 7) as well as another thickener (0.15 wt% of CELLOSIZ QP-15,000, hydroxyethyl cellulose), without associative thickener, which would improve flow and leveling and sag resistance inherently, but examples in said new 1.132 declaration does not show use of said clay and hydroxyethyl cellulose even

though the instant examples (TFW-463-2-4) used clay. Thus, new 1.132 declaration is inconclusive.

4. Applicant asserts that Elsik et al failed to flow and leveling and sag resistance, but applicant failed to show that example 3 of Elsik et al does not have such properties. Good flow and leveling and sag resistance properties are inherently required in paints and coating composition.

5. A composition comprising 1 wt% of a latex and 0.1 wt% of the recited boehmite particles falls within scope of the instant claims, but such composition would not have recited values for flow and leveling and sag resistance based on the data in new 1.132 declaration in which a large amount of solid component (rutile titanium dioxide and a latex) which improves said flow and leveling and sag resistance properties are used, and applicant failed to show otherwise.

Claims 1, 4, 7, 10-22, 24, 26-34 and 55-59 are rejected under 35 U.S.C. 103(a) as obvious over Elsik et al (US 5,550,180) and Bugosh (US 2,915,475), and in view of Gernon et al (US 2006/0106129 A1).

Rejection is maintained for reason of record with above under Elsik et al and following response.

1. Applicant's assertion with respect to Elsik et al has been addressed above.
2. Bugosh teaches the instant aspect ratios and use of 1-40% of said boehmite in aqueous paints, and Bugosh is cited to show the instant aspect ratios and a dimension, not a composition and other properties as asserted by applicant.

3, Again, with respect to applicant's assertion with respect to the activated boehmite particles, Elsik et al teach employing ammonium hydroxide which inherently activates boehmite particles.

4. With respect to applicant's assertion with respect to Gernon et al, the examiner has pointed out following properties which are well known in paints;

A. A commercial latex paint has a pH greater than 7 such as 9.0 ± 0.2 as taught in example 2. Thus, such pH also inherently activates added boehmite particles of Elsik et al.

B. Set to dry time of 10 minutes is seen in table 3, and the instant value is common for a latex paint.

C. Viscosity values in KU (83-93) in said table 3 are higher than KU values shown in the instant example of table 1 (68 and 72), and very good leveling score of 8 is also seen. Thus, said higher viscosity would yield the instant flow and leveling value and sag resistance.

Contrary to applicant's assertion that a leveling score of 8 is in a latex containing associative thickeners, compositions for said table 3 do not contain associative thickeners, see formulation in PP [0062] and associative thickener in PP [0034] which is absent from PP [0062].

Note that Gernon et al are cited to show the art known facts such as pH, set to dry time and viscosity of a commercial latex paint.

Contrary to applicant's assertion, the examiner has not asserted inherency in combination of references. Inherency is based solely on Elsik et al. and Bugosh and Gernon et al further show other properties claimed and well known facts in paints.

Claims 1, 4, 7, 10-22, 24, 26-34 and 55-59 are rejected under 35 U.S.C. 103(a) as obvious over Bugosh (US 2,915,475) and Gernon et al (US 2006/0106129 A1)..

Rejection is maintained for reason of record with above and following response.

The examiner is suggesting add boehmite particles of Bugosh in example 2 of Gernon et al, or to use paint formulation in example 2 of Gernon et al in Bugosh since Bugosh teach use of said boehmite particles in coatings and paints.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tae H Yoon/
Primary Examiner
Art Unit 1796

THY/February 13, 2009